improper, violate the holdings of many different court decisions and cannot be maintained.

Section §101 Rejection

The Examiner asserts that "claims 1-33 are rejected on the ground that they infringe on U.S. laws set forth by Congress. The U.S. department of commerce, working under the authority of Congress, is under contract with ICANN for the domain name registration system that they may have no jurisdiction over." The Applicant traverses all of the Examiner's assertions.

Section101 Response

First, the United States Patent and Trademark Office (USPTO) has issued seven patents that include the terms "domain name registration" in the claims. See Table 1 below created by the searching the USPTO web site at www.uspto.gov on June 5, 2006. In addition, there are 25 published patent applications what include the terms "domain name registration" in their claims.

1	7,039,697	Registry-integrated internet domain name acquisition system
2	7,020,602	Native language domain name registration and usage
3	6,980,990	Internet domain name registration system
4	6,895,430	Method and apparatus for integrating resolution services, registration services, and search services
5	6,760,746	Method, product, and apparatus for processing a data request
6	6,678,717	Method, product, and apparatus for requesting a network resource
7	6,167,449	System and method for identifying and locating services on multiple heterogeneous networks using a query by type

Table 1.

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Table 2 includes an additional 13 issued patent that include the terms "domain name registry" in the claims.

1	7,039,697	Registry-integrated internet domain name acquisition system
2	7,003,661	Methods and systems for automated authentication, processing and issuance of digital certificates
3	7,000,028	Automated domain name registration
4	6,980,990	Internet domain name registration system
5	6,854,074	Method of remotely monitoring an internet web site
6	6,842,770	Method and system for seamlessly accessing remotely stored files
7	6,839,759	Method for establishing secure communication link between computers of virtual private network without user entering any cryptographic information
8	6,826,616	Method for establishing secure communication link between computers of virtual private network
9	6,735,585	Method for search engine generating supplemented search not included in conventional search result identifying entity data related to portion of located web page
10	6,687,733	Method and system for automatically configuring a client-server network
11	6,519,859	System and method for generating domain names and for facilitating registration and transfer of the same
12	6,654,813	Dynamically categorizing entity information
13	6,018,761	System for adding to electronic mail messages information obtained from sources external to the electronic mail transport process

Table 2.

These patents issued to individuals and organizations, as far as the Applicant can tell, are not related to ICANN. If the USPTO has no authority to grant a patent including domain name registrations or registries, how did the USPTO grant such patents already? Patent 7,039, 697 entitled "Registry-integrated internet domain name acquisition system," was granted on May 2, 2006. Clearly, this wasn't illegal and the USPTO had the authority to grant such a patent.

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If the Examiner is correct, which does not appear to be the case, the USPTO has already violated U.S. laws set forth by Congress by issuing the patents in Tables 1 and Table 2. If the Examiner is incorrect, and that appears to be the case in the matter, the USPTO is not treating all applicant's for patents related to domain names fairly in violation of the patent rules.

Second, the Applicant's invention includes, in general, managing domain name registrations obtained from a public domain name registrar and paying fees back to the public domain name registrar to maintain a permanent domain name registration. This clearly can not and does not infringe on the laws of the United States as set forth by Congress or their contract with ICANN as the public domain name register issues the domain name registrations and is paid for their maintenance.

Third, if the Applicant's invention did violate the laws the United States, why did the Examiner further apply the patent laws of the United States and reject the Applicant's invention under Section 103 of the patent laws? If what the Examiner asserted was true, there would be no need to further apply any additional sections of the patent laws.

Fourth, the Examiner cited the U.S. Patent No. 6,519,589 to Mann et al. against the Applicant which a patent invention including a system for generating a domain name and for facilitating its registration with a public domain name registrar. If the Mann invention does not infringe U.S. law as set forth by Congress how can the Applicant's?

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The Examiner has clearly incorrectly applied Section 101. The Applicant requests the Section 101 rejection be immediately withdrawn.

First Section 103 Rejection

Claims 1-13 and 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

First Section 103 Response

The Examiner is reminded that to establish prima facie obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). A *prima facie* case of obviousness may also be rebutted by showing in the cited art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

Claim 1

Claim 1 recites "*a method for protecting domain name registrations with a permanent registration certificate, comprising (1) accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system; (2) accepting a one-time permanent registration fee for the domain name registration on the permanent domain name*

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registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; (3) storing the accepted information in one or more databases associated with the permanent domain name registration system; (4) issuing a permanent registration certificate for the domain name registration, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system." (Parenthesized numbers not in original claim added by Applicant in this paper for discussion purposes only).

First, the Examiner asserted that Claim 1 is rejected over "Applicant Admitted Prior Art." However, the Applicant did not file any Information Disclosure Statements (IDS) that included the two patents, Mann, or Koritzinsky as cited by the Examiner as Applicant Admitted Prior Art.

Second with respect to the patent to Hagan, the Applicant filed an IDS including a the Hagan patent. However, the Applicant made no such admissions with respect to Hagan being relevant prior art. The Applicant clearly states in the letters filed with each of the IDSs that *"The references have not been reviewed in sufficient detail to make any other representation and, in particular, no representation is indented as to the relative importance of any portion of the references. This Statement is not a representation that the cited references have effective dates early enough to be 'prior art' within the meaning of 35 U.S.C. sections 102 or 103."*

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Third, the Examiner rejected Claim 1 in part in view of Hagan. However the Examiner provided no assertions or commentary for Hagan with respect to Claim 1. Clarification is requested as to the rejections of Claim 1 in view of Hagan.

Next, the Examiner asserts that Mann teaches " a method of obtaining information (plurality of names) from a public domain registrar for domain name registration (See Abstract)." By the Examiner's own words this does not match what is recited by the first element of Claim 1 which recites "*accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;*"

In contrast to the Examiner's assertions, Mann actually teaches a "System and method for generating domain names and for facilitating registration and transfer of the same." (Title). This teaches away from what is recited by the first element of Claim 1 which includes obtaining information for a domain name that has been already registered with a public domain name registrar.

Third, Mann further teaches "New and improved systems and methods for generating and facilitating registration and transfer of available domain names. The systems and methods include and involve a data storage facility for storing at least one adjunct term for use in generating at least one registerable domain name, and a processor arrangement which is coupled to the data storage facility and which is configured to be accessed by a user system via an electronic data network, to receive at least one root term from the user system, to concatenate at least one root term with at least one adjunct term to generate at least one candidate domain name, to query a data source to determine if the candidate domain name(s) is available for

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registration and/or transfer, and to notify the user system of the candidate domain name(s) when the same are available for registration and/or transfer." (Abstract)

Thus, the Abstract cited by the Examiner includes teachings that not only teach away from the claimed invention but also clearly does not teach or suggest the first element of Applicant's Claim 1.

The Examiner then admits that Mann does not teach or suggest the claim elements two and part of four of Claim 1 of "*accepting a one-time registration payment fee that can be used to perpetually pay for all future renewal fees for domain name registration instead of paying annually or pay-per-use.*"

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Since Mann does not teach or suggest element one as discussed above or element two or part of four by the Examiner's own admissions, the Examiner has not established a *prima facie* case of obviousness for the claimed invention in view of Mann in violation of the holdings of *In re Royka*. Thus, Claim 1 is not obvious and the Section 103 rejection should be immediately withdrawn.

The Applicant need not respond any further. However, for completeness the Applicant responds as follows.

The Examiner is reminded that even if a case of *prima facie* obviousness is established, which is not the case in the matter as was described above, a *prima facie* case of obviousness may be rebutted by showing in the cited art, in any

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material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

Mann clearly teaches away from the claimed invention by requesting root terms, generating domain names using the root terms and determining if the generated domain name is available for registration (Abstract). This clearly teaches away from the Applicant's invention as recited by Claim 1 which has not such limitations.

In addition, Mann clearly teaches "Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority)." Col. 8, lines 4-6. This clearly teaches away from the Applicant's invention as recited by Claim 1. Thus, if a *prima facie* case of obviousness did somehow exist in view solely of Mann, the Applicant has also rebutted it based on the holding of *In re* Geisler.

The Examiner is also reminded that obviousness can only established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. *In Re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). If a proposed modification or combination of the prior art would change the principle

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operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* 270 F.2d 810 (CCPA 1959).

The Examiner then asserts Koritzinsky et al teaches the "general concept of paying for a subscribed service such as (a) pay per use, (b) annually (c) periodically, or (d) permanently for the benefit of lifetime service or non-expiring warranty service with one-time payment of fee (one-time service) (See column 21, lines 16-31, col. 22, lines 50-58). It would have been obvious to modify the fee payment process of Mann by using option (d) or one-time payment of fee (one time fee service) as taught by Koritizinsky for the benefit as cited above, which is lifetime service or non-expiring warranty services."

First, Mann does teach suggest or even mention a payment process for domain names as the Examiner asserts. If the Examiner thinks that Mann teaches a fee payment process the Applicant requests the Examiner specifically state the column and lines in Mann where a fee payment process is taught or suggested.

Second, Koritzinksky teaches "an Imaging system protocol handling method and apparatus" (Title) and "A technique is disclosed for providing programs, such as operational protocols, to medical diagnostic institutions and systems. The protocols are created and stored on machine readable media. A description of the protocols is displayed at the diagnostic institution or system. A user may select a desired protocol or program from a user interface, such as a listing of protocols. The protocol listing may include textual and exemplary image descriptions of the protocols. Selected protocols are transferred from the machine readable media to the

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diagnostic institution or system. The transfer may take place over a network link, and may be subject to fee arrangements, subscription status verifications, and so forth. Protocols may be loaded for execution on system scanners by selection from the same or a similar protocol listing screen." (Abstract). Thus, Koritzinsky primarily teaches handling protocols of medical imaging services.

Third, Koritzinsky does not teach, suggest or even mention domain names or domain name registrations anywhere, period.

Fourth, combining Mann and Koritzinsky still does not teach or suggest what is recited by the claimed invention. Mann teaches a method for generating domain names and for facilitating registration of the domain names. (Abstract). Koritzinsky teaches an imaging system protocol handling method and apparatus for medical imaging (Title and Abstract). Adding a one-time payment for medical imaging diagnostic services from Koritzinsky to the system and method for generating and facilitating registration of domain names does not teach or suggest what is recited by the claimed invention.

Fifth, there is no motivation to combine Mann with Koritzinsky because because Koritzinsky changes at least one principal operation of Mann and renders Mann unsatisfactory for one of its intended purposes in violation of the holdings of *In re Fine*, *In Re Gordon* and *In re Ratti*.

For example, Mann teaches generating a domain name from a root word obtained from a user, checking the availability of the generated domain name, notifying a user of the availability of a domain name and allowing a user an option

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to register an available domain name with a domain name registrar (Abstract, Col. 3, line 40 through Col. 8, line 16 and Claims.).

Mann clearly teaches at Col. 8, lines 4-7, "In the preceding discussion, registration of available domain names has been mentioned as an option related to an available domain name generated in accordance with the present invention... Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority).

Thus, there is no motivation to combine Mann and Koritizinsky as the Examiner suggests. Even if Mann and Koritzinsky were combined, the combination still does teach or suggest the claimed invention as the Examiner suggests.

The Examiner further asserts that "as for the limitation of a permanent registration certificate, Mann would normally issue a registration certificate based on the type of payment of fee."

This is an incorrect statement based on the teachings of Mann. As was discussed above Mann clearly teaches "Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority)." Col. 8, lines 4-6. This it is the domain name authority and not Mann that issues the domain name registration certificate.

Finally, the Examiner asserts that "the issuance of a permanent registration certificate is inherent included in combination with Koritzinsky." This is again an incorrect statement since Mann does not issue domain name registration

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certificates, the domain name registration authority does so Mann does not explicitly or inherently teach issuing a domain name registration certificate. In addition, Koritzinsky does not explicitly or inherently teach or suggest a permanent domain name registration certificates because Koritzinsky does not teach or suggest or even mention domain names.

Thus, there is no motivation to combine Mann and Koritzinsky. Trying to do so violates the holdings of *In re Fine, In Re Gordon* and *In re Ratti.*

The Applicant has clearly shown why Claim 1 is not obvious over Mann in view of Koritzinsky. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claim 1. Since this claim is not obvious it should be immediately allowable in its present form.

Claims 2-9

The Examiner is reminded that if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

All of arguments for Claim 1 are incorporated by reference. Claims 2-9 add additional limitations not present in Claim 1.

The Applicant has clearly pointed out why Independent Claim 1 is not obvious. Thus, Claims 2-9 are not obvious under the holding of *In re Fine.*

In addition, Applicant responds to the Examiner's assertion that the additional limitations described in Claims 2-9 are inherent.

The Examiner is reminded that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the

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thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

The Examiner clearly has not met the burden of proof for inherency under *In re Robertson*. No person skilled in the art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate, a lifetime subscription warranty, plural shares in the permanent domain name registration, a lease on the permanent domain name registration, co-ownership on the permanent domain name registration or any of the other additional limitations described by Claims 2-9.

In addition, the Applicant traverses all of the Examiners assertions of concepts described by the limitations in Claims 2-9 as being well known. The Examiner's assertions include several errors with respect to Claims 2-9. None of the concepts the Examiner described as well known had ever been associated with permanent domain name registrations. In fact most of the statements the Examiner asserted as well known are not even well know with respect to the Internet. And certainly not well known with respect to use with domain names or permanent domain name registrations.

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Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 2-9. Since these claims are not obvious they should all be immediately allowable in there present form.

Claims 19-34

All of arguments for Claim 1 are incorporated by reference. Claims 19-34 include similar claim limitations related to permanent domain name registrations as are recited by Claim 1.

The Applicant has clearly pointed out why Independent Claims 1 is are not obvious. Thus, Claims 19-34 are not obvious by the same arguments outlined for Claim 1.

Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 19-34. Since these claims are not obvious they should all be immediately allowable in there present form.

Second Section 103 Rejection

Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Second Section 103 Response

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Claim 10

The Applicant accepts the Examiner's *admission* that Koritzinsky *"failed to teach using the permanent registration fee to be added to a financial instrument who profit can be used to perpetually pay future renewal fees."*

The Examiner further asserts, Hagan discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay by contractually defining events (Abstract line 22). Motivation to combine Koritzinsky and Hagan is to generate income to peretually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann and in further view of lifetime/service/benefit/guarantee as taught by Koritzinsky."

All of the arguments for Claim 1 above are incorporated by reference for Claim 10 and further apply in view of Hagan. The combination of these three references still does not teach or suggest the claimed invention claimed by Claim 10.

Thus, Claims 10 is not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 10 in view of Hagan. Since this claims is not obvious it should all be immediately allowable in its present form.

Third Section 103 Rejection

Claims 14-18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider (U.S. Patent No. 6,901, 436 in view of Koritzinsky (U.S. Patent No. 6,272,469).

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The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Third Section 103 Response

Claims 14-18

The Applicant accepts the Examiner's admission that Schneider does not teach "*determining a renewal fee, paying a renewal fee, transferring additional renewal fee payments to maintain the right of the domain name.*"

Neither Schneider nor Koritzinsky teach, suggest or even mention permanent domain names or permanent domain name registrations claimed by the Applicant.

All of the arguments for Claims 1 and 10 above are incorporated by reference in view of Schneider. The combination of these three references still does not teach or suggest the claimed invention.

Thus, Claims 14-18 is not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 14-18 in view of Schneider. Since this claims is not obvious it should all be immediately allowable in their present form.

Fourth Section 103 Rejection

Claims 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the

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Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Fourth Section 103 Response

Claims 19-34

Applicants accepts all of the Examiner's *admissions* with respect to Claims 21, 22, and 30-34.

All of the arguments for Claims 1 and 10 above are incorporated by reference. The combination of these three references still does not teach or suggest the claimed invention.

The Examiner is reminded that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*.

The Examiner clearly has not met the burden of proof for inherency under *In re Robertson*. No person skilled in the art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate, a lifetime subscription warranty, plural shares in the permanent domain name registration, a lease on the permanent domain name registration, co-ownership on the permanent domain name registration or any of the other additional limitations described by the claims.

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In addition, the Applicant traverses all of the Examiners assertions of concepts described by the limitations in these as being well known. The Examiner's assertions include several errors with respect to claims. None of the concepts the Examiner described as well known had ever been associated with permanent domain name registrations. In fact most of the statements the Examiner asserted as well know are not even well know with respect to the Internet.

Thus, Claims 19-34 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 19-34. Since this claims is not obvious it should all be immediately allowable in their present form.

CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §101 and §103 rejections of claims 1-34 and pass all of the claims immediately to allowance.

Respectfully submitted.
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Dated: June 6, 2006

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